

REMARKS

Claims 28-30, 32, 33, 35-37, 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hitachi (JP 05-197444) in view of Mitsubishi (JP 02-129689) and in further view of Matsushita (JP 06-161636). Claims 31 and 38 have been indicated as allowable if rewritten in independent form.

There is no suggestion, motivation or teaching of the desirability to make the specific combination claimed by the Applicant in independent claims 28 and 35. *See e.g., In re Kotzab*, 55 U.S.P.Q. 2d 1313 (Fed. Cir. 2000) (“to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.”). As such, a *prima facie* case of obviousness has not been established.

Hitachi fails to disclose configuring a first display to receive a pen-based input as called for in independent claim 28. Further, Hitachi fails to disclose a second display adapted to receive a pen-based input as called for in independent claim 35. Paper No. 16, page 2. Using inappropriate hindsight, the Examiner combines Mitsubishi and Matsushita in further combination with Hitachi to formulate the 103(a) rejection.

For example, the Examiner relies on Mitsubishi as teaching two displays (5) and (6) and a separate unit containing a keyboard (3) where the first display (6) includes a touch tablet for inputting position information. Paper No. 16, pages 2-3. Further, the Examiner relies on Matsushita as teaching a tablet that is used to accept a pen input (Figure 3; paragraphs 0021-0023). *Id.* However, merely identifying individual components of the claim does not support an obviousness type rejection. *See, e.g., In re Kotzab*, 55 U.S.P.Q. 2d 1313 (Fed. Cir. 2000). Rather, “particular findings must be made as to the reasons a skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed.” *Id.* Toward this end, the Examiner should specifically recite language in the references that support the given rationale to combine. *See, e.g., Ex Parte Jones*, 62 U.S.P.Q. 2d 1206, 1208 (Bd. of Patent App. & Interferences 2001) (“Moreover, when an examiner maintains

that there is an explicit or implicit teaching or suggestion in the prior art, the examiner should indicate where (page and line or figure) such a teaching or suggestion appears in the prior art”).

Here, the Examiner supplies nothing other than hindsight reasoning. The Office Action states that “it would have been obvious... to provide one of the displays in Hitachi with the tablet, being motivated by Mitsubishi, because it would add an important feature such as entering position information directly onto display by a pen...”. Paper No. 16, page 3. However, aside from identifying various components, the Examiner has failed to show where in the art there is a suggestion or motivation to make the specific combination as claimed. Mere conclusions about what is obvious do not constitute “particular findings” or “evidence” as required. *See, In re Kotzab*, 55 U.S.P.Q. 2d 1313 (Fed. Cir. 2000) (“Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not ‘evidence’”) citations omitted. The Examiner has merely concluded what he believes is obvious without making the particular findings as is required. Thus, for at least this reason, claims 28 and 35 are not obvious.

Further, it is respectfully submitted that the Hitachi reference is not clear regarding the separateness of the unit containing a keyboard (3). For example, in the description of the drawing section of the computer generated translation that was provided by the Examiner, it states that drawing 4 shows an example of the content of a display of two displays in the busy condition of the portable machines and equipment shown in drawing 3. Further, referring to paragraph [0012], there is a discussion regarding drawing 3. Within that paragraph and directly after the discussion of drawing 3, it is stated “[a]t this time, display 4 and 5 shows the same content of a display to the anti-vertical sense, as shown in drawing 4.” Hitachi, at paragraph [0012]. Taken together, Figure 4 may simply illustrate what persons 1 and 2 view on the displays 4 and 5 when they are in use, as shown in Figure 3. Thus, it is respectfully submitted, that Hitachi does not clearly teach the limitations of providing a computer having a first display, a second display, and a base unit containing a keyboard, the unit separate from the first and second displays, as called for in claim 28 or a unit separate from a first and second display, as

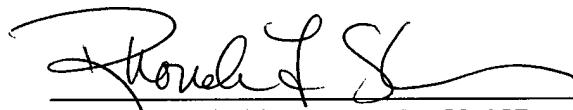
called for in claim 35. For this additional reason, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

For at least the reasons set forth above, it is respectfully requested that the rejection of claims 28-30, 32, 33, 35-37 and 39-41 be withdrawn. As such, the application is believed to be in condition for allowance. The Examiner's prompt attention in accordance therewith is respectfully requested.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (MCT.0094US).

Respectfully submitted,

Date: July 25, 2003



Rhonda L. Sheldon, Reg. No. 50,457

Customer No. 21906

TROP, PRUNER & HU, P.C.

8554 Katy Freeway, Suite 100

Houston, Texas 77024

(713) 468-8880 [Phone]

(713) 468-8883 [Fax]